



JUL 10 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Richard L. Mayer  
KENYON & KENYON  
One Broadway  
New York, New York 10004

In re Application of  
OHMS, Franz  
Application No.: 09/623,342  
PCT No.: PCT/DE98/03741  
Int. Filing Date: 21 December 1998  
Priority Date: 05 March 1998  
Attorney Docket No.: 10191/1577  
For: SWITCHING CONTROLLER

DECISION ON  
PAPERS UNDER 37 CFR 1.42

The is a response to the declaration filed 22 March 2001 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

**BACKGROUND**

On 21 December 1998, applicant filed international application no. PCT/DE98/03741 which claimed a priority date of 05 March 1998 and designated the United States. On 28 September 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 05 September 2000.

On 31 August 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and an international search report.

On 22 September 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 22 March 2001, applicant filed "Response to Missing Requirements under 35 U.S.C. 371" which was accompanied by, among other items: a declaration and power of attorney executed by Gabriele Ohms on behalf of deceased inventor, Franz Ohms and a translation of the international application.

**DISCUSSION**

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 22 March 2001 was executed by Gabriele Ohms on behalf of deceased inventor Franz Ohms. However, the declaration does not state that the relationship of Gabriele Ohms to the deceased inventor. Absent a statement that the signing heir is the sole heir or legal representative (executor) of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42. See also 37 CFR 1.497(b)(2).

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith  
PCT Legal Examiner  
PCT Legal Office



Anthony Smith  
Attorney Advisor  
PCT Legal Office  
Tel: (703) 308-6314  
Fax: (703) 308-6459